

### **REMARKS**

This paper is in response to the official action dated February 26, 2004 (hereafter, "the official action"). This paper is timely-filed as it is accompanied by a petition for an extension of time to file in the first month and a check covering the requisite small entity extension fee.

Prior to entry of the foregoing amendments, claims 1-20 were pending. By the foregoing amendments, claims 1, 4, 8, and 15 have been amended. Support for the amendment to claims 1, 4, 8, and 15 may be found variously throughout the application and in the claims as originally filed. No new matter has been added.

In the official action, claims 1-7 and 12-20 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,825,253 to Speyer (hereafter, "Speyer") in view of U.S. Patent No. 6,193,635 to Webber *et al.* (hereafter, "Webber"), U.S. Patent No. 4,971,305 to Rennex (hereafter, "Rennex"), U.S. Patent No. 4,444,396 to Wendt (hereafter "Wendt"), and in further view of the Choice1 Medical Distributors website advertisement "Hausmann Pulley Weights: Extra 2 lb Weight Plate" (hereafter, "Choice1"). Claims 8-11 have been rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,193,635 to Webber *et al.* (hereafter, "Webber") in view of Rennex, U.S. Wendt, and in further view of Choice1.

The various bases for the claim rejections will be addressed in the order presented in the official action. Reconsideration of the application, as amended and in view of the following remarks, is solicited.

### **CLAIM REJECTIONS**

The applicants respectfully traverse the rejections of claims 1-7 as obvious over Speyer in view of Webber, Rennex, Wendt, and in further view of Choice1.

A prima facie case of obviousness requires three basic criteria. *First*, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. *Second*, there must be a reasonable expectation of success in doing so. *Third*, prior art references, when combined, must teach or suggest all of the claim limitations. See M.P.E.P. §2142.

At least the third criteria has not been satisfied with respect to claims 1-7, as explained in more detail below. In view of this deficiency, the applicant respectfully submits that the obviousness rejections of claims 1-7 should be withdrawn.

Claims 1-7:

Claims 1-7 recite a plurality of incremental weights that have been structurally adapted for use with a conventional weight training apparatus such as a standard barbell or a cable-type apparatus. The plurality of incremental weights includes at least one *very light* incremental weight selected from the group consisting of a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight. When one or more of such *very light* incremental weights is used in weight training methods in accordance with invention, *small incremental gains in strength can be continuously achieved* substantially without risk of failure. Thus, the incremental weight systems and apparatus in accordance with the invention allow weight lifters to overcome “plateaus” in their weight training programs, thereby making weight training more satisfying. See present application at page 6, lines 7-12.

Speyer discloses a weight training apparatus comprising a barbell and a set of free weights including a centrally disposed bore and a slot. Speyer appears to disclose a standard weight increment of 10 pounds in Figure 8. Consistent with this observation, the examiner indicated that Speyer does *not* disclose or suggest a plurality of incremental weights as recited by claims 1-7. See official action at page 2.

Thus, the examiner turned to Webber, Rennex, Wendt, and Choice<sup>1</sup>. Based on these disclosures, the examiner asserted that it would have been obvious to modify “Speyer’s weight plates into any of an array of sizes from 1/8 ounce to 45 pounds since the use of such a range of sizes is known in the exercise art as shown by the representative references above and the practice of incrementally adding weight plates of various sizes during exercise....” See official action at pages 2-3. However, the use of a very small incremental weight selected from the group consisting of a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce

weight, and a two-ounce weight in weight training methods is not disclosed or suggested by any of the cited references (alone or in combination). Accordingly, the rejections of claims 1-7 should be withdrawn.

Webber merely discloses a standard cable-type weight training apparatus and a set of plate/weights of standard increments such as 5 pounds, 10 pounds, etc. *See* Webber at column 6, lines 14-17. Webber also generally discloses add-on plates "in various incremental weights of 5 lbs or less." *See* Webber at column 6, lines 43-44. Webber therefore does not disclose or suggest an incremental weight structurally adapted for use in conventional weight training methods and selected from the group consisting of a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by claims 1-7.

Rennex discloses "a device which enables weight trainers to more conveniently select a particular weight and to make this weight selection with smaller weight increments than heretofore has been possible." *See* Rennex abstract. Rennex discloses increments as small as 0.2 pounds (*i.e.*, 3.2 ounces). Despite disclosing increments as small as 0.2 pounds, Rennex does not disclose any advantage that is specific to using such a small increment in conventional weight training methods relative to a larger increment (e.g., between 0.2 pounds and 5.0 pounds). *See* Rennex at column 3, lines 10-12 and 40-43. Thus, Rennex does not disclose any motivation for using an incremental weight structurally adapted for use in conventional weight training methods and selected from the group consisting of a lightest incremental weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by claims 1-7.

The examiner asserted that Wendt discloses "an exercise device that utilizes weight plates of various sizes weighing 1, 2, 4, 8 and 16 ounces...." *See* official action at page 2. However, Wendt *merely* discloses a set of circular disks comprising one-ounce, two-ounce, four-ounce, eight-ounce, and sixteen-ounce weights, which can be used in conjunction with a *golf club* to provide a weighted golf club for "gradually increasing the strength, stamina and suppleness of the muscles of a golfer so as to enable him to play golf to the best of his ability." *See* Wendt at column 1, lines 17-22. Thus, Wendt does not disclose or suggest an incremental weight

structurally adapted for use in conventional weight training methods and selected from the group consisting of a lightest incremental weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by claims 1-7.

Additionally, Wendt is nonanalogous art relative to Speyer because Wendt is exclusively directed to golf-related activities whereas Speyer discloses a barbell exercising device. Thus, the rejection should also be withdrawn because it is improper to rely on a reference which is not "in the field of the applicant's endeavor or ... reasonably pertinent to the particular problem with which the invention was concerned." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992).

Finally, Choice1 *merely* discloses a two pound plate for use with a standard cable-type weight training apparatus. Therefore, Choice1 does not disclose or suggest an incremental weight structurally adapted for use in conventional weight training methods and selected from the group consisting of a one quarter-ounce weight, a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by claims 1-7. Moreover, Choice1 illustrates the nonobviousness of the incremental weights in accordance with the invention because Choice1 provides a relatively large increment (*i.e.*, a two pound plate) as the lowest weight increment for weight training methods using a cable-type weight training apparatus. Such increments provide too large of an increase for adults, and such an increase in exercise resistance is proportionally larger for children. *See* present application at page 1, line 30 to page 2, line 2. Therefore, the applicant respectfully submits that further evidence of the non-obviousness of the claimed subject matter is that Choice1 actually teaches away from the claimed invention by teaching such a large weight increment.

Because none of the cited references discloses or suggests an incremental weight structurally adapted for use in conventional weight training methods and selected from the group consisting of a lightest incremental weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by claims 1-7, the rejection should be withdrawn.

Claims 12-14:

Claims 12-14 are directed to incremental weights structurally adapted for use in conventional weight training methods and having a weight of about one quarter-ounce, one half-ounce, and one-ounce, respectively. The applicant respectfully traverses the rejection of claims 12-14 as obvious over Speyer in view of Webber, Rennex, Wendt, and in further view of Choice1 for the reasons provided above with respect to claims 1-7.

Claims 15-20:

Claims 15-20 are directed to methods of incrementally increasing a person's strength by incremental weight training. The applicant respectfully traverses the rejection of claims 15-20 as obvious over Speyer in view of Webber, Rennex, Wendt, and in further view of Choice1 for the reasons provided above with respect to claims 1-7. Moreover, the applicant respectfully submits that none of the cited references teaches executing a weight training exercise an incrementally increased resistance to consistently achieve small incremental gains in strength with causing injury and/or failure.

Claims 8-11:

The applicants respectfully traverse the rejections of claims 8-11 as obvious over Webber, Rennex, Wendt, and in further view of Choice1 for the reasons provided above with respect to claims 1-7.

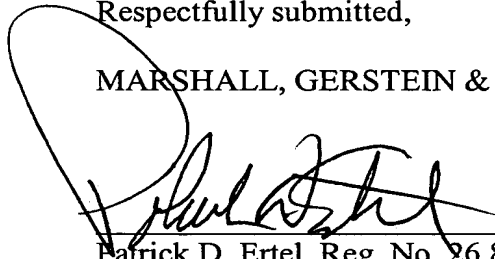
CONCLUSION

It is respectfully submitted that the application is now in condition for allowance. Should the examiner wish to discuss the foregoing amendments and/or comments, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned attorney at the indicated telephone number.

June 28, 2004

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

A handwritten signature in black ink, appearing to read 'Patrick D. Ertel', is written over a horizontal line.

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